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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,995	03/10/2002	Michael J. Curry	1049.002US1	2530
23441 7590 05/27/2010 LAW OFFICES OF MICHAEL DRYJA 1230 E Baseline Rd #103-248 Mesa, AZ 85204				
EXAMINER DINH, KHANH Q				
ART UNIT 2451		PAPER NUMBER		
NOTIFICATION DATE 05/27/2010		DELIVERY MODE ELECTRONIC		

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MICHAEL J. CURRY, RUDY D. MARTIN, DOUGLAS Z. PAN,  
and RICHARD T. SIMONI JR.

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Appeal 2009-006478  
Application 09/683,995<sup>1</sup>  
Technology Center 2400

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Decided: May 25, 2010

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*Before* LEE E. BARRETT, JAY P. LUCAS, and DEBRA K. STEPHENS,  
*Administrative Patent Judges.*

LUCAS, *Administrative Patent Judge.*

DECISION ON APPEAL

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<sup>1</sup> Application filed March 10, 2002. The real party in interest is Talkway, Inc. of Fremont, California.

### STATEMENT OF THE CASE

Appellants appeal from a final rejection of claims 1 to 24 under authority of 35 U.S.C. § 134(a). The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

We reverse.

Appellants' invention relates to an e-mail messaging system with built-in audio and video capabilities. In the words of Appellants:

An email messaging program with built in video and/or audio media recording and/or playback capabilities is disclosed. A system includes first and second clients, each having an email messaging program installed thereon. The user of the first client composes a message and records media. In a streaming media embodiment, the first client's messaging program uploads the media to a streaming media server, and sends the message to the user of the second client. In a file attachment embodiment, the messaging program attaches the recorded media to the message, and sends the message to the user of the second client. The second client's messaging program retrieves the message. In the streaming media embodiment, when the user of the second client views the message, the messaging program downloads the media from the streaming media server, and plays back the media. In the file attachment embodiment, the messaging program plays back the media.

(Abstract, Spec. 18).

Claim 1 is exemplary:

1. A system comprising:

a network;

a first client having a first email messaging program installed thereon, a composing user composing a message on the first email messaging program, the composing user recording media on the first email messaging program, the first email messaging program sending the message and the media to a receiving user over the network; and,

a second client having a second email messaging program installed thereon on which the receiving user receives the message over the network, the second email messaging program playing back the media upon the user viewing the message,

wherein the first email messaging program sends the message and the media over the network by itself, without having to use any other email messaging program on the first client.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Budge

US 6,564,248 B1

May 13, 2003  
(filed on Dec. 07, 1999)

#### REJECTION

The Examiner rejects the claims as follows:

Claims 1 to 24 stand rejected under 35 U.S.C. § 102(e) for being anticipated by Budge.

Appellants contend that Budge does not anticipate the claimed subject matter as the references fails to teach claimed limitations. The Examiner contends that each of the claims is properly rejected.

### ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 102(e). The issue specifically turns on whether the reference Budge teaches a messaging program as claimed sending a message and associated media over a network by itself, without using any other messaging program.

### FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Appellants have invented a system and method for adding video or audio media to an e-mail message (Spec. 3, ¶ [0010]). Two embodiments are disclosed: one sends in the e-mail message a link to a streaming video server, and the other one attaches the recorded media to the message (Spec 3, top; ¶ [0008]).
2. The Budge reference teaches creating a video or audio attachment to an e-mail message, adding the media component to a conventional e-mail client, such as Eudora (Col. 3, line 40).

## PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation." *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citation omitted).

Anticipation of a patent claim requires a finding that the claim at issue 'reads on' a prior art reference. In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.

*Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed. Cir. 1999) (internal citations omitted).

[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed *but also all of the limitations arranged or combined in the same way as recited in the claim*, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.

*Net MoneyIN, Inc. v. VeriSign et al.*, 545 F.3d 1359, 1371 (Fed. Cir.

## ANALYSIS

From our review of the administrative record, we find that the Examiner presents his conclusions of unpatentability on pages 3 to 10 of the Examiner's Answer. In opposition, Appellants present a single argument.

*Argument with respect to the rejection  
of claims 1 to 24  
under 35 U.S.C. § 102(e)*

The Examiner has rejected claims 1 to 24 for being anticipated by Budge. Appellants argue that in Budge, “the software 50 on which a user records media and on which the user composes a message is NOT the same program that sends the message and the media over the network – rather, a different computer program – the conventional e-mail client – is the program that actually sends the message and the media over the network.” (App. Br. 6, bottom [emphasis omitted]).

We have carefully considered the Budge patent and find merit in the Appellants' argument. The claim clearly requires a first e-mail messaging program on which a user records media (e.g. video) and which sends the message and media to a receiving user (claim 1, second limitation). Further, the claim clearly also requires that the first e-mail messaging program sends the message and media over the network by itself, without having to use any other e-mail messaging program on the first client (claim 1, last limitation). Budge teaches that the e-mail client is a separate program from the program making the recording. The recording is made by video e-mail recorder 210;

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the e-mail client is a commercial off the shelf product 270, such as Eudora (Col 3, l. 40; col. 1, l. 41).

We thus find that Budge is not a sufficient teaching to anticipate the representative claim 1.

#### CONCLUSIONS OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner erred in rejecting claims 1 to 24.

#### DECISION

We reverse the Examiner's rejection of claims 1 to 24.

REVERSED

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